

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

At the outset, Applicants note that the 3/29/2006 office action was improperly made final and that this finality should be withdrawn. By way of example, the 2/24/2005 office action rejected claim 46 as allegedly being anticipated by Darling et al. (WO 93/23125). Claim 46 was not amended in the 8/24/2005 response, but has now been rejected as allegedly being “obvious” over Darling in further view of Hilgendorf et al. (U.S. Patent No. 5,249,800).¹ This new ground of rejection of claim 46 was not necessitated by any amendment made by Applicants inasmuch as no amendment of this claim was made. For at least this reason, the finality of the 3/29/2006 office action is improper and should be withdrawn.

Claim 17 was rejected under 35 U.S.C. Section 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the office action contends that the specification does not disclose “a processing system operable in response to user inputs to transmit message (sic) via the paging system ‘only’ if sufficient message credits are stored in the memory.” Applicants traverse this contention and note that paragraphs [00008] and [00113] to [00119], for example, provide support for the feature specified in claim 17. Moreover, original claim 4 of the parent application no. 09/659,738, filed September 11, 2000 (now U.S. Patent No. 6,716,103), expressly specifies transmitting messages via a paging system “only” if the number of message credits stored in a memory is greater than a number of message credits needed to transmit the messages. For the Examiner’s convenient reference, a copy of the originally-filed claims of the parent ‘738 application is included in the Appendix. For at least these

¹ Indeed, the 3/29/2006 office action expressly notes with respect to claim 46 that “Darling et al. fails to teach of the processing system in (sic) responsive to a received message for disabling the communication circuitry” (emphasis added).

reasons, the subject matter of claim 17 cannot possibly constitute new matter as alleged in the office action and withdrawal of this rejection is respectfully requested.

Claims 17-29, 46 and 54-67² were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-44 of U.S. Patent No. 6,716,103. For the reasons set forth below, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 17-28 correspond to claims 51-62 of the above-mentioned parent '738 application. See claims 51-62 in the Appendix. As explained in Applicants' 8/24/2005 response, these claims were the subject of a restriction requirement dated August 7, 2002 during the prosecution of the parent '738 application. A copy of this restriction requirement was attached to the 8/24/2005 response and is now part of the on-line image file wrapper for the subject patent application. 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a restriction requirement has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. See also MPEP Section 804.01. The 3/29/2006 Office Action provides no response to this argument, nor any explanation as to how a double patenting rejection can be properly maintained in view of the restriction requirement in the parent application. Consequently, reconsideration and withdrawal of the double-patenting rejection of claims 17-28 is respectfully requested.

Like claim 17, claim 29 calls for transmitting messages via a paging system if sufficient message credits are stored in a memory. Consequently, this claim corresponds to the subject matter that was restricted in the parent '738 application. Reconsideration and withdrawal of the double-patenting rejection of claim 29 is respectfully requested.

With respect to claims 46, 54-63 and 65-67, the office action sets forth no basis whatsoever for a double patenting rejection. The office action suggests that “[a] similar analysis [to that for claims 17 and 29] can be made between at least claim 31 of the instant application and at least claim 40 of the patent.” First, claim 31 is no longer

² Applicants note that claim 64 was previously canceled.

pending in this application. Second, a generalized statement regarding a “similar” analysis does not satisfy the USPTO’s burden of providing a *prima facie* basis for a rejection. In view of the absence of any showing of a basis for the double patenting rejection of claims 46, 54-63 and 65-67, this rejection must be withdrawn.

Claims 46, 56, 57, 60, 62, 64 and 65 were rejected under 35 U.S.C. Section 103(a) as allegedly being “obvious” over Darling et al. and further in view of Hilgendorf et al.

Claim 46 is directed to a hand-held game machine comprising a display, radio frequency communication circuitry for transmitting and receiving messages over a wireless communication network, and a processing system for executing a video game program, wherein the processing system is responsive to a received message for disabling the radio frequency communication circuitry. The office action acknowledges the deficiency of Darling et al. with respect to disabling the radio frequency communication circuitry, but alleges that col. 6, line 61 to col. 7, line 3 of Hilgendorf et al. “teach of the processing system responsive to a received message for disabling the communication circuitry.” 3/29/2006 office action, page 5.

The referenced portion of Hilgendorf et al. is from patent claims 23 and 24, which relate to a disable signal for disabling slot machines when a fault is detected. While Hilgendorf et al. describes the disabling of slot machines under certain conditions, there is no disclosure or suggestion therein of radio frequency communication circuitry for a wireless communication network, or the disabling of such circuitry in response to a received message. Consequently, the proposed combination of Darling et al. and Hilgendorf et al. is deficient at least with respect to this feature of claim 46.

In response to the arguments about claim 46 presented in the 8/24/2005 response, the office action states, “the applicant argues that Darling et al. does not disclose all the claim limitations, [but the examiner] respectfully disagrees with the applicant.” 3/29/2006 office action, page 15. However, page 5 of the 3/29/2006 office action notes with respect to claim 46 that “Darling et al. fails to teach of the processing system in (sic) responsive to a received message for disabling the communication circuitry” (emphasis added) and the office action then references another document as allegedly providing this feature. Thus, contrary to the page 15 statement, in fact, it appears that the Examiner

actually agrees with Applicants' prior arguments regarding Darling et al.'s deficiencies with respect to claim 46.

Claims 56, 57, 60, 62, 64 and 65 all depend from claim 55. Because claim 55 is rejected based on a proposed combination of Darling et al., Wagner et al. and Marrs, Applicants respectfully submit that claims 56, 57, 60, 62, 64 and 65, which depend from claim 55, are not properly rejected based on a combination of only Darling et al. with Hilgendorf et al., where Hilgendorf et al. is only referenced in connection with its disclosure of disabling slot machines.

Claim 54 was rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Wagner et al. ("Human Factors Design Guide"). Claim 54 depends from claim 46 and neither Darling et al. nor Wagner et al. discloses a processing system that is responsive to a received message for disabling radio frequency communication circuitry. Consequently, even if Darling et al. were for some reason provided with a touch-sensitive screen based on Wagner et al. as proposed in the office action, the result would still be deficient with respect to the features of claim 46, from which claim 54 depends.

Claims 17-26 and 29 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. (WO 93/23125) in view of Marrs (U.S. Patent No. 5,376,931).

Independent claims 17 and 29 each calls for transmitting messages only if sufficient message credits are stored in a memory. Darling et al. contains no disclosure relevant to this feature. Marrs clearly and unambiguously relates to a message debiting system in which debit units are debited from a debit meter to enable presentation of a stored message. However, each of claims 17 and 29 relates to transmitting messages only if sufficient message credits are stored in a memory. Nothing in Darling et al. or Marrs discloses or suggests conditioning the transmitting of messages on sufficient message credits as claimed and the combination of these documents would likewise be deficient in this regard. Consequently, the proposed combination of Darling et al. and Marrs would not have made the subject matter of claims 17 and 29 obvious.

The office action responds to these arguments by noting that

Marrs teaches of debiting unit that enables access to the stored message when there is sufficient number of available credit units in the debit meter and disables access to the message when the debit meter is depleted ...It would have been obvious to one in ordinary skill to modify Marrs to enable access to transmit message only if sufficient number of credits are available in the debit meter and disable access to transmit message when the debit meter is depleted, similar to received message options, thus allowing user to pay per individual messages rather than pay monthly charges. 3/29/2006 Office Action, page 14 (emphasis added).

Thus, the office action acknowledges that Marrs does not disclose the claimed feature, but instead maintains that it would have been obvious to modify Marrs to provide this feature. First, no such argument is present in the actual rejection on pages 7 and 8 of the office action, where it is simply alleged that it would have been obvious to incorporate Marrs' debit meter into Darling et al. Second, by admitting that Marrs' must be further modified to provide the claimed feature, the office action expressly concedes that the combination of Darling et al. and Marrs is in fact deficient with respect to claims 17 and 29. Third, there is no evidence of record to support the contention that it would have been obvious to modify Marrs as proposed in the office action. The mere statement that it would have been obvious to do something is not a surrogate for the evidence required to sustain a rejection.

Applicants traverse the rejections of claims 18-26 and 29 and do not acquiesce in the characterization of the applied references with respect to these claims. In any event, these claims depend from claim 17 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

Claims 27 and 28 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Marrs, and further in view of Taskett et al. (U.S. Patent No. 6,044,247). Taskett et al. is cited for its purported disclosure of a paging card for replenishing a pager account balance. However, the account balance in Taskett et al. relates to accessing voice messages or phone numbers via a call controller 306 and then making telephone calls. Taskett et al. does not cure the above-noted deficiencies of Darling et al. and Marrs with respect to claim 17 (from which claims 27 and 28 depend)

and thus even if the combination were proper, the subject matter of claims 27 and 28 would not have resulted.

Claims 55, 58, 59, 61, 63, 66 and 67 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Darling et al. in view of Wagner et al. and further in view of Marrs.

Claim 55 calls for a storage device for storing user-defined graphics and symbols for composing messages. Wagner et al. and Marrs provide no disclosure relevant to storing user-defined graphics and symbols for composing messages. The office action nonetheless maintains that this feature is an obvious design-choice because, among other things, "applicant has not disclosed that storing user-defined messages solves any stated problem or is for any particular purpose and it appears that the memory 22 in the game machine 10 of Darling et al. would perform equally well storing both predefined messages and user-defined messages." Nothing in 35 U.S.C Section 103 relieves the USPTO of its responsibility to provide evidence of obviousness because of an alleged failure, for example, to disclose that a particular feature solves a problem or is for a particular purpose. There is simply no documentary evidence of record that establishes the obviousness of modifying Darling et al. to provide this feature.

The office action responds to these arguments by stating:

A computer memory, which in this case is used as storage device, breaks everything down to 0's and 1's (binary numbers) and uses their combination to store user-defined messages (words, phrases, graphics, symbols and audio pieces etc.). Consequently for the purpose of storage within the memory there is no difference between a (sic) words, phrases, graphics, except for different combinations of 1's and 0's, thus there is no difference to store graphics or words or any other player inputs, it would have been obvious to store the user defined message within the memory.

3/29/2006 office action, page 16.

Claim 55 calls for storing user-defined graphics and symbols for composing messages and thus the conclusion that "it would have been obvious to store a user defined message" within a memory (even assuming without admitting this were correct) would not establish the obviousness of the claimed subject matter. Moreover, the arguments based on the contention that everything is broken into 0's and 1's effectively concedes

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that there is no disclosure or suggestion of storing user-defined graphics and symbols for composing messages in the applied references.

Applicants traverse the rejections of claims 58, 59, 61, 63, 66 and 67 and do not acquiesce in the characterization of the applied references with respect to these claims. In any event, these claims depend from claim 55 and are believed to be allowable because of this dependency and because of the additional patentable features contained therein.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,
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